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EXAMINER

REFAI, RAMSEY

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/935,859	Applicant(s) ENARI, MASAHIKO	
	Examiner Ramsey Refai	Art Unit 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6, 8-10, 12-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Responsive to Request for Continued Examination (RCE) filed December 1, 2008. Claims 6, 9-10, and 14 were amended. Claims 7 and 11 were canceled. Claims 14-22 are new. Claims 6, 8-10, 12-22 are pending.

Response to Arguments

1. Applicant's arguments have been fully considered but they are not persuasive.

- In the remarks, the Applicant argues with substance:

Argument A: *the limitation "enabling the customer to view physical commodities on a screen of the store terminal that are available for purchase, in addition to the electronic content items" is supported by the Applicant's specification and requests withdrawal of the 112, first rejections.*

In the remarks, the Examiner respectfully disagrees. The Applicant has cited various citations of alleged support; however none of the cited portions are **in the context of a method for providing electronic content to a customer using a remote user terminal and a store terminal via a first and second communication channel** as claimed. The alleged support include citations from different embodiments, including online shopping, retrieval of goods via a vending machine, and opening a menu screen to view car related services. None of the cited portions appear to be related to a method for providing electronic content to a customer using a remote user terminal and a store terminal via a first and second communication channel. The rejection is maintained.

Argument B: *Rautila does not teach the identification code corresponds only to the electronic content item.*

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In response, the Examiner respectfully disagrees. After the user selects a particular digital product desired from among the titles available on the electronic shop server (column 6, lines 1-8), the user receives a unique order number, which corresponds to the selected digital product (column 9, lines 60-63, column 6, lines 1-8 and 35-38). The unique order number is used to obtain the desired digital product from the electronic shop server which meets the limitation of “an identification code corresponds only to the electronic content item”. Therefore Rautila meets the scope of the claimed limitation.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 6, 8-10 12-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 6 and 10 include the feature “enabling the customer to view physical commodities on a screen of the store terminal that are available for purchase, in addition to the electronic content items” appears to lack proper support in the disclosure.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 6, 8-10,12-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 6 and 10 appear disjointed. The claims were originally directed to a method and system for providing electronic content to a customer using a remote terminal and a store terminal via a first and a second communication channel. Now the claims include the limitation directed to enabling the customer to view commodities on a screen of the store terminal which appears to be part of a different embodiment unrelated to the method originally presented.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6, 8-10, 12-18, 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rautila (US Patent No. 6,714,797) in view of Jones (US 6,697,944) in further view of Burke et al (US 6,604,681).

7. As per claim 6, Rautila teaches a method for providing electronic content to a customer using a remote user terminal and a store information terminal, the method comprising the steps of:

accessing a menu including a plurality of electronic content items available for purchase using the remote user terminal (**column 6, lines 2-7**);

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selecting an electronic content item using the remote user terminal (**column 6, lines 5-7**);

obtaining an identification code, via a first communication channel (**column 6, line 1; internet 150**), for individually identifying the retrieved electronic content item (**column 6, line 35-40, column 8, lines 31-37**); wherein the identification code corresponds to the electronic content item (**column 9, lines 60-63, column 6, lines 1-8 and 35-38**);

inputting the identification code at the store information terminal (**column 6, lines 50-53**);

enabling the customer to purchase (**column 6, lines 53-64**), via a second communication channel, the second communication channel being different from the first communication channel (**hotspot network 50**), the retrieved electronic content item corresponding to the identification code (**column 6, lines 50-64**); and

enabling the customer to download the electronic content item from the store information terminal (**column 6, line 53-column 7, line 5**); and

Rautila fail to explicitly teach enabling the customer to download the electronic content item from the store information terminal *to a portable recording medium loaded into the store information terminal*. However, in the same field of endeavor, Jones et al teach a kiosk with a USB interface that allows a user to download content onto the USB (**see at least column 11, lines 45-50, fig 4**).

Furthermore, Rautila fail to teach *enabling the customer to view on a screen of the store information terminal physical commodities that are available for purchase*. However, in the same field of endeavor, Burke et al teach a touch screen kiosk in a store that allow customers to view and purchase goods in the store (**see at least column 3, lines 3-9**). It would have been obvious to one of ordinary skill in the art to combine the teachings of Rautila, Jones et al, and

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Burke et al because doing so would allow a customer in Rautila to download the content on to a portable medium from a kiosk at the store and to view goods available in the store for purchase.

Additionally, it is noted that **KSR** forecloses the argument that a **specific** teaching, suggestion, or motivation is required to support a finding of obviousness. Under **KSR**, a claim would have been obvious if the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than **predictable results** to one of ordinary skill in the art at the time of the invention.

8. As per claim 8, Rautila teaches wherein the menu including the plurality of electronic content items available for purchase is located on a server accessible by the remote user terminal via a network **(column 6, lines 2-8)**.

9. As per claim 9, Rautila teaches wherein the step of obtaining the identification code comprises downloading the identification code to a portable recording medium **(column 6, lines 35-38; unique order number downloaded to mobile station 10)**.

10. As per claims 10, 12-13, these claims contain similar limitations as claims 6, 8-9 above, therefore are rejected under the same rationale.

11. As per claims 14, 21, in Rautila-Jones et al-Burke, Burke teach when the consumer first touches the kiosk display screen, the screen shows a plurality of product categories and subcategories but fails to explicitly teach wherein the screen displays an opening screen comprising *at least one of a car menu, a book menu, a shipping menu, a photo print menu, a*

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massage service menu, a music download menu, a travel menu, and a ticket menu. However, it would have been obvious to one of ordinary skill in the art to modify Rautila-Jones et al-Burke to include a book menu category because doing so would allow a user to view books available for purchase at the store.

12. As per claim 15, Rautila teach wherein the car menu is used to open a car-related menus for at least one of retrieval and sale of a car, retrieval and sale of car goods, and renting of a car **(limitation met since only one menu (book menu) is required by claim 14).**

13. As per claim 16, Rautila teach wherein a selection of the photo print menu by the customer provides a service for printing recordings made by an electronic still camera.
(limitation met since only one menu (book menu) is required by claim 14).

14. As per claim 17, Rautila fail to teach *wherein the screen displays a list of recommended pieces of music and a promotion video.* However, in the same field of endeavor, Kaplan teach that a list of recommended music and a promotional video are displayed on a kiosk screen **(see at least figs 5A-5F, 39, column 2, lines 35-41).** It would have been obvious to one of ordinary skill in the art to combine Kaplan with Rautila-Jones et al-Burke because doing so would allow a user to view recommended content and view a video regarding products available for purchase.

15. As per claim 18, Rautila fail to teach *wherein a list of goods related to an artist is displayed on the screen when an artist goods menu is selected by the customer.* However, in the same field of endeavor, Kaplan teaches a list of available albums relating to an artist is displayed on a kiosk screen **(see at least figs 6A-6C).** It would have been obvious to one of

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ordinary skill in the art to combine Kaplan with Rautila-Jones et al-Burke because doing so would allow

16. As per claims 20, 22, Rautila-Jones et al-Burke teaches providing an ability to use the store terminal to purchase one of the physical commodities that is not displayed in a store **(Burke: see at least column 3, lines 3-9) .**

17. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rautila (US Patent No. 6,714,797) in view of Jones (US 6,697,944) in further view of Burke et al (US 6,604,681) in view of "Official Notice".

18. As per claim 19, Rautila fails to teach *wherein a list of scheduled concerts related to an artist is displayed on the screen when a ticket menu is selected by the customer*. However, "Official Notice" is taken that the concept and advantage of this feature is well known in the art. It would have been obvious to one of ordinary skill in the art to modify Rautila-Jones et al-Burke to include this feature because doing so would allow a customer to also order tickets for a scheduled concert using the kiosk at the store.

Conclusion

Furthermore, claims directed to an apparatus must be distinguished from the prior art in terms of **structure rather than function**, In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex

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parte Masham, 2 USPQ2d 1647 (Bd Pat. App & Inter. 1987). Thus, the structural limitation of claim 1, including a storage medium and one or more processors is disclosed by Sturgeon et al as described above. Also, as described above, the functional limitations in claim 1 do not distinguish the claimed apparatus from the prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Refai whose telephone number is (571) 272-3975. The examiner can normally be reached on M-F 8:30 - 5:00 p.m. .

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on (571) 272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free)? If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ramsey Refai
December 18, 2008
/Ramsey Refai/
Examiner, Art Unit 3627